

MAY 19 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Edward J. Cheal et al.

Serial No.: 10/605,322

Filed: September 22, 2003

For: *Joint Prosthesis and Components  
Thereof*

Art Unit: 3738

Examiner: Stewart, Alvin

Confirmation No.: 2321

Atty. Docket: APK-001.02

Certificate of Transmission under 37 C.F.R. § 1.8

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office on May 19, 2005 to facsimile number 703-872-9306.

*Teri Barbuto*

Teri Barbuto

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

RESPONSE

Sir:

This Amendment is filed in response to the non-final Office Action mailed May 17, 2005. No fees are believed payable, but the Commissioner is authorized to charge any required fee to Deposit Account No. 06-1448, reference APK-001.02. Applicants claim entitlement to small entity status.

*Claim Rejections - 35 U.S.C. § 103(a)*

Claims 1, 2, 9, and 13-16 were rejected under 35 U.S.C. § 103(a) as reciting subject matter unpatentable over U.S. Pat. No. 5,906,644 to Powell in view of U.S. Pat. No.

6,319,286 to Fernandez et al. Claims 3, 4, 17, and 18 were rejected as reciting subject matter unpatentable over Powell in view of Fernandez and further in view of U.S. Pat. No. 5,653,764 to Murphy. Claim 5 was rejected as reciting subject matter unpatentable over Powell in view of Fernandez and further in view of U.S. Pat. No. 5,002,578 to Luman. Claim 6 was rejected as reciting subject matter unpatentable over Powell in view of Fernandez and further in view of U.S. Pat. No. 5,080,674 to Jacobs et al. Claims 7, 8, 19, and 20-25 were rejected as reciting subject matter unpatentable over Powell in view of Fernandez and further in view of U.S. Pat. No. 5,653,765 to McTighe et al.

In response, Applicants ask the Examiner to reconsider and withdraw these rejections because the Fernandez patent is not prior art.

The present application is a continuation of U.S. App. No. 09/583,805, filed May 30, 2000, which claims the benefit of U.S. Provisional App. No. 60/136,815, filed June 1, 1999 and U.S. Provisional App. No. 60/168,526, filed December 2, 1999. Joint prostheses within the scopes of independent claims 1 and 13 are disclosed in the provisional patent applications. See, for example, Fig. 2 of the '815 provisional application and the related disclosure on pages 13-14. See also Figs. 1, 2A-B, and 4 of the '526 provisional and the related disclosure on page 11.

Fernandez, in contrast, was filed on March 13, 2000, so its disclosure of the claimed joint prostheses is irrelevant; Fernandez does not predate Applicants' valid priority claim.

Copies of Applicants' provisional applications are readily available through the Image File Wrapper system, so no copies are provided herewith.

Applicants reserve the right to remark further on whether Fernandez's disclosure would anticipate or render obvious the subject matter of any claims if Fernandez were considered to be prior art.

Applicants invite the Examiner to contact their attorney Scott Kamholz to discuss any matter related to this application. Mr. Kamholz can be reached at 617-832-1176 (direct) or at the telephone number listed below.

Dated: May 19, 2005  
Customer No. 25,181  
FOLEY HOAG LLP  
155 Seaport Blvd  
Boston MA 02210-2600  
Tel.: (617) 832-1230  
Fax: (617) 832-7000

Respectfully submitted,  
FOLEY HOAG LLP



---

Scott E. Kamholz  
Reg. No. 48,543  
Attorney for Applicants